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## TRANSMITTAL FORM

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Filing Date	September 24, 2001
First Named Inventor	Masaaki HIROKI et al.
Group Art Unit	2871
Examiner Name	Mike Qi
Attorney Docket Number	0756-2367

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosures 1. Correction to Previously Submitted IDS and PTO 1449 Form 2. 3. 4. 5.
<b>Remarks</b> <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 50-2280 for the above identified docket number.		

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Eric J. Robinson, Reg. No. 38,285 Robinson Intellectual Property Law Office, P.C. PMB 955 21010 Southbank Street Potomac Falls, VA 20165
Signature	
Date	January 12, 2007

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Attorney Docket No. 0756-2367

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Masaaki HIROKI et al.  
Serial No. 09/961,055  
Filed: September 24, 2001  
For: ELECTRO-OPTICAL DEVICE

) Group Art Unit: 2871  
)

) Examiner: Mike Qi  
)

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2007.

Adrian Stumper

RESPONSE

Honorable Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Official Action mailed October 12, 2006, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on November 2, 2001; November 30, 2001; April 18, 2002; September 20, 2002; May 9, 2003; January 30, 2004; June 16, 2004; March 8, 2005; June 27, 2005; August 11, 2005; and October 12, 2005.

A further Correction to Previously Submitted Information Disclosure Statement is submitted herewith and consideration of this Correction is respectfully requested.

Claims 2, 4, 6-9, 19, 21, 24-42, 44-58 are pending in the present application. Claims 24-36 and 48-58 have been withdrawn from consideration by the Examiner (Box 4a, Office Action Summary, Paper No. 20060926). Accordingly, claims 2, 4, 6-9, 19, 21, 37-42 and 44-47 are currently elected, of which claims 2, 4, 6-9 and 37-42 are

independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 2, 4, 6-9, 19, 21, 37-42 and 44-47 as obvious based on the combination of U.S. Patent No. 5,051,570 to Tsujikawa, U.S. Patent No. 4,007,294 to Woods and U.S. Patent No. 4,778,258 to Parks. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Tsujikawa, Woods and Parks or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official

Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

The test for obviousness is not whether the references "could have been" combined or modified as asserted in the Official Action, but rather whether the references should have been. As noted in MPEP § 2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original). Thus, it is respectfully submitted that the standard set forth in the Official Action is improper to support a finding of *prima facie* obviousness.

Claims 2, 4, 6-9 and 37-42 recite that the claimed pixel electrode is transparent. The Official Action concedes that Tsujikawa and Woods do not teach "that the pixel electrode is transparent" (page 5, Paper No. 20060926).

As noted in the previous *Amendment*, Tsujikawa is directed to a light valve. That is, in Tsujikawa, a light signal enters from a rear side of a panel and is detected by the photodiode 101 while projection light enters from a front side of the panel and is reflected by pixel electrode 124. "The pixel electrode 124 has light reflecting and light blocking properties" (column 11, lines 16-18). The light signal and the projection light are used separately in the panel. If pixel electrode 124 were made transparent, the projection light would enter the photodiode through the transparent pixel electrode and the entire device would be rendered inoperable, because the photodiode should be switched by a light signal. Therefore, the Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art at the time of the present invention to modify Tsujikawa by changing pixel electrode 124 of Tsujikawa into a transparent electrode.

The Official Action newly cites Parks. However, Parks does not cure the deficiencies in the alleged motivation to combine Tsujikawa and Woods. The Official Action asserts that "Parks teaches ... pixel electrode having transparent material (transparent pixel electrode), and that is particularly useful in LCD displays in which back lighting is employed to form or assist in forming the desired image" (page 5, Paper No. 20060926). The Official Action further asserts that "it would have been obvious ... to modify the electro-optical display device of Tsujikawa and film treatment of Woods with the teachings of using transparent pixel electrode as taught by Parks, since the skilled in the art would be motivated for achieving a desired image, particularly, for the transmission type liquid crystal display as indicated in paragraph 0147 of this application" (*Id.*). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

The Official Action has failed to set forth *prima facie* evidence as to why one of ordinary skill in the art at the time of the present invention would have been motivated to modify Tsujikawa by changing the reflective pixel electrode 124 of Tsujikawa into a transparent electrode. For the reasons noted above, it appears that such a combination would destroy the underlying functionality and intended purpose of Tsujikawa and possibly make the device of Tsujikawa inoperative for its intended purpose. As noted in detail above, Tsujikawa's device is a light valve, so incident light should be reflected by the pixel electrode. Also, Tsujikawa suggests a desirability of completely covering the two thin film transistors 3 and 4 by the pixel electrode 24 so that the projected light is prevented from reaching these elements (see column 9, lines 35-40). Therefore, Tsujikawa teaches away from using a transparent pixel electrode, and Woods and Parks do not teach or suggest contravening the intended function of Tsujikawa in favor of a transparent electrode.

Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

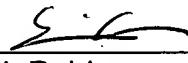
modify Tsujikawa, Woods and Parks or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
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